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EXAMINER

WOLFSCHLAGER, JEFFREY MICHAEL

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JOHANNES J. MEERMAN
and WIELMUS M. ROELOFS

Appeal 2010-011414
Application 10/500,713
Technology Center 1700

Before CHARLES F. WARREN, PETER F. KRATZ, and
LINDA M. GAUDETTE, *Administrative Patent Judges*.

KRATZ, *Administrative Patent Judge*.

DECISION ON APPEAL

This is a decision on an appeal under 35 U.S.C. § 134 from the Examiner's final rejection of claims 1-7. We have jurisdiction pursuant to 35 U.S.C. § 6. Oral arguments were presented on September 14, 2011.

Appellants' claimed invention is directed to a method for manufacturing filaments from an optically anisotropic spinning solution. Claim 1 is illustrative and reproduced below:

1. A method for manufacturing filaments from an optically anisotropic spinning solution comprising extruding the spinning solution through a spinneret comprising a spinning field with a plurality of spinning orifices into a coagulation bath through a slot or diaphragm, the edges of the slot or diaphragm being formed by plates with upper sides and lower sides, the upper side of each plate being defined as the side having the shortest distance to the spinning field, wherein a line through the center of the spinning field and perpendicular to the upper sides is located at a distance (d) from a parallel line through the center of the slot or diaphragm, wherein the slot or diaphragm has substantially the same size and shape as the spinning field, and wherein the plane of the upper side of one of the plates has a shorter distance to the center of the spinning field than the plane of the upper side of the other of the plates, and the line through the center of the spinning field has a smaller distance to the edge of one of the plates than to the edge of the other of the plates, and wherein the slot or diaphragm is positioned at the bottom of the coagulation bath.

No references are relied upon by the Examiner as evidence in rejecting the appealed claims.

In addition to the originally filed Application disclosure, including cited portions thereof, Appellants rely on a cited European Patent disclosure, referred to at page 1 of the Specification, as filed, and two Declarations under 37 C.F.R. § 1.132 by Dr. Stephen J. Picken (Declaration I filed on April 28, 2008 and Declaration II filed on July 15, 2008).¹

¹ See the Evidence Appendix (App. Br. 46 et seq.). Also, Appellants refer to a published copy of the Application for Patent (US 2005/0179162 A1), a

The Examiner maintains the following ground of rejection:

Claims 1-7 stand rejected under 35 U.S.C. § 112, first paragraph as failing to comply with the written description requirement.

In addition, the Examiner objects to the drawing amendments filed April 30, 2007 pursuant to 35 U.S.C. § 132 as introducing new matter.²

We reverse the written description rejection for reasons argued by Appellants. We generally adopt Appellants' statement of facts (F.F.) as set forth in the Appeal Brief as they relate to the original disclosure in

copy of a Request for Reconsideration after Final Rejection submitted by Appellants, the Final Rejection, and an Advisory Action issued by the Examiner (App. Br., Evid. Appx.). It is noted that Appellants generally use the paragraph numbering employed in the published Application disclosure in referring to the Application Specification in the proposed statement of facts (see; e.g., App. Br. 10-25).

² Objections to the drawings are generally directed to a petitionable matter rather than a matter decided on appeal. Appellants urge that the objection here is reviewable on appeal because the objection, like the written description rejection, involves new matter (App. Br. 9, note 1). However, the drawings submitted by an amendment filed on April 30, 2007, which are objected to by the Examiner, include details, such as depicted in Figure 2, that are not required by the claims subject to the written description rejection before us. For example, a bath bottom is depicted in the proposed replacement sheet containing Figure 2, which shows an opening between elements 9a and 9b that is different than the slot opening 5 between plates 7a and 7b. Elements 9a and 9b refer to the lower sides of the plates 7a and 7b according to the Specification, as filed (paragraph bridging pages 4 and 5). The latter features are not required by the portion of claims 1 and 2 that is asserted to lack written descriptive support. Consequently, Appellants have not established that the objection to the drawings is sufficiently intertwined with the written description rejection before us that it necessitates our resolution of the drawing objection as an appealable matter as part of this appeal. Accordingly, we do not reach the drawing objection as a matter that is properly raised before us for resolution as part of this appeal.

Appellants' Specification, unless otherwise indicated (App. Br.10 - 25). Our reasoning follows.

ISSUE

Did the Appellants indicate by their argument that the Examiner erred in determining that the appealed claims lack the requisite written descriptive support in the Specification, as filed, for certain amended claim recitations?

DISCUSSION

As our reviewing court stated in *In re Kaslow*, 707 F.2d 1366, 1375 (Fed. Cir. 1983):

The test for determining compliance with the written description requirement is whether the disclosure of the application as originally filed reasonably conveys to the artisan that the inventor had possession at that time of the later claimed subject matter, rather than the presence or absence of literal support in the specification for the claim language...The content of the drawings may also be considered in determining compliance with the written description requirement. [Citations omitted.]

The Examiner has the initial burden of setting forth evidence or reasons why, as a matter of fact, the written description in the Specification as originally filed would not have reasonably conveyed to a person having ordinary skill in this art that the inventors were in possession of the invention defined by the appealed claims, including all of the limitations thereof, at the time the Application was filed. *See, e.g., In re Alton*, 76 F.3d 1168, 1172, 1175-76 (Fed. Cir. 1996) (*citing In re Wertheim*, 541 F.2d 257, 262-64 (CCPA 1976)). Alleging a lack of literal support is not enough to

carry the Examiner's initial burden. *In re Voss*, 557 F.2d 812, 817 (CCPA 1977); *In re Edwards*, 568 F.2d 1349, 1354 (CCPA 1978).

In an effort to satisfy this burden, the Examiner contends that the Specification, as originally filed, does not describe the recitation “wherein the slot or diaphragm is positioned at the bottom of the coagulation bath” as it appears in independent claims 1 and 2 because this proviso regarding the positioning of the slot or diaphragm “does not appear to be supported by the original disclosure” (Ans. 4).

However, contrary to the Examiner's contention, we agree with Appellants that the Examiner has not discharged the burden to establish that the Application disclosure, as filed, fails to furnish written descriptive support for the contested recitations of the rejected claims by the rejection presentation. In this regard, the Examiner's rejection focuses on words allegedly not used in the Specification and refers to a replacement Figure 2 filed on April 30, 2007 rather than explaining why, in the Examiner's view, the description in the Application taken as a whole (including the pertinent referenced drawing figures), as originally filed, would not have been reasonably understood as conveying to a person having ordinary skill in the art that the named inventors were in possession of the claimed invention, including the allegedly non-described limitation, at the time of filing.

The Examiner argues that the wherein recitation indicating the slot or diaphragm positioning at the bottom of the coagulation bath as recited in claims 1 and 2 is not supported by the Specification, as originally filed (Ans. 4). In this regard, we note that the recitations in claims 1 and 2 regarding the slot or diaphragm positioning do not reference the replacement Figure 2 filed

on April 30, 2007 as showing the location claimed, as indicated by the Examiner in the rejection statement.

However, we agree with Appellants that the original Specification would have made it plain to one of ordinary skill in the art that the discharge openings described as being located at the bottom of the bath reasonably fixes the positioning of the slot or diaphragm as being at the bottom of the bath (App. Br. 26-37; Reply Br. 2-12). This is because the discharge openings referenced at several locations of the originally filed Specification would have been understood by one of ordinary skill in the art as being defined by the described slots or diaphragms as explained by Appellants in the Appeal Brief and as Dr. Picken attests in the Declarations (*see*, e.g., App. Br. 14 (F.F. 21), 18 (F.F. 35), 23 (F.F. 0035), 24 (F.F. 73 and F.F. 74), and 26-37; Declaration I, Item No. 8; and Declaration II, item No. 8).

Appellants acknowledge via the testimony of Dr. Picken that originally filed drawing Figure 2 appears to be in error in depicting, with an unnumbered outline, a coagulant bath container seemingly having a bath bottom with no outlets, and which bath bottom is lower than the plates 7 defining a depicted slot or diaphragm 5 (Declaration I, Item 8). This is because this figure is plainly contrary to the original Specification disclosure respecting the bottom discharge openings for removing filaments from the bath (Spec. pp. 1 and 4; App. Br. 24 (F.F. 74) and 28-33). Consequently, this originally filed drawing figure would not have been an impediment to one of ordinary skill in the art recognizing that Appellants were in possession of the claimed invention, including the slot or diaphragm positioning at the bath bottom, as recited in appealed claims 1 and 2.

Concerning the Examiner's response to argument as presented in the Examiner's Answer, we are not persuaded thereby for reasons outlined above and as more fully presented by Appellants in the Appeal Brief and Reply Brief taken together with the testimony of Dr. Picken in the Declarations of record, copies of which were submitted with the Appeal Brief. In this regard and consistent with the original Specification disclosure, Dr. Picken makes it plain that Applicants' diaphragm or slot must be positioned at the coagulation bath bottom, not at a location above a bottom bath outlet (Declaration II, Item 8). The Examiner's rebuttal argument to the effect that a diaphragm or slot could be positioned above a bottom bath outlet consistently with the original Specification disclosure of a method and apparatus for manufacturing filaments is insufficient to outweigh the testimony of Dr. Picken indicating the impossibility of such an arrangement providing for fiber transport (Ans. 8-9).

On this record, Appellants have identified reversible error in the Examiner's assertion of a lack of written descriptive support for the claimed subject matter; that is, that the Specification does not reasonably convey to one of ordinary skill in the art that the Applicants were in possession of the claimed method and apparatus, including the limitations identified by the Examiner.

Accordingly, we reverse the Examiner's decision rejecting claims 1-7 under 35 U.S.C. § 112, first paragraph as failing to comply with the written description requirement.

ORDER

The Examiner's decision to reject the appealed claims is reversed.

REVERSED

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